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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,623	07/07/2007	John Anthony Downes	091351-011000	1812
33717 7590 04/13/2009 GREENBERG TRAURIG LLP (L.A.) 2450 COLORADO AVENUE, SUITE 400E INTELLECTUAL PROPERTY DEPARTMENT SANTA MONICA, CA 90404				
EXAMINER SWENSON, BRIAN L				
ART UNIT 3618		PAPER NUMBER		
MAIL DATE 04/13/2009		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/599,623

Applicant(s)

DOWNES, JOHN ANTHONY

Examiner

BRIAN SWENSON

Art Unit

3618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 October 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date 12/28/06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application.
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claims 1, 6, 8 and 9 are objected to because of the following informalities: the phase "the or each passage" is unclear. The examiner suggests the language -- the at least one passage -- . This phase is found in lines 4-7 in Claim 1; lines 2 of Claims 6 and 9; and lines 1 and 2 of Claim 8.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3-4 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3 and 4 recite the limitation "the baffles" in line 1 of Claims 3-4; and the limitation "its respective baffle" in Claim 9. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4, 6-10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by UK Patent No. 2,229,689 issued to Downes (cited in the IDS filed 28 December 2006).

Downes teaches in Figures 1-3 and respective portions of the specification of: A device (Figure 1) for preventing spray from emerging from the wheels of vehicles comprising a panel (elements 4 and 5) that is adapted to be mounted substantially vertically behind a vehicle wheel (Figure 1) for receiving on a first side (see element 4's location in Figure 1) water released by the wheel as it rotates (see page 2, paragraphs 2-4), the panel including at least one passage (6) which leads from the first side to a rear second side of the panel (see Figure 3), the at least one passage being other than normal to the plane of the panel (see Figure 3), and at least one water-collecting pocket (7) along the side of the at least one passage, wherein, in use, air and water entering the at least one passage are separated so that air passes through the at least one passage and mixes with ambient air on a second side of the panel, and water collects in the at least one water-collecting pocket (see page 2, paragraphs 2-3).

In re claims 2-4, 6-10 and 12, see Figure 3 where the passages are substantially identical in U-shaped, overlap each other, non-linear, arranged to collect water following several changes in direction of the passage and allowing the water to drain onto the running surface (see page 2, paragraph 4).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Downes in view of U.S. Patent No. 5,257,822 issued to Metcalf.

The panel shown by Downes is shown extend from the top of a wheel well to a substantially planar portion located behind the wheel.

The use of spray guards that are substantially planar is well known in the vehicle art. Metcalf, for example, shows a substantially planar spray guard (1) located behind a wheel.

It would have been obvious to one having ordinary skill in the art at the time of invention to provide a substantially planar spray guard located behind a wheel, as taught by Metcalf, in the invention taught by Metcalf. One would be motivated to provide substantially planar spray guard to allow the spray guard to be easily replaced for maintenance.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,375,882 issued to Koch, III teaches of a plurality of planar panels for reducing spray from a vehicle.

U.S. Patent No. 6,799,782 issued to Jain et al. of spray and splash suppressor.

U.S. Patent No. 4,362,310 and 4,372,570 issued to Goodall teach of a screen (Figure 8) for reducing spray.

U.S. Patent No. 3,341,222 issued to Roberts teaches of a spray collector.

U.S. Patent No. 5,199,742 issued to Gotz et al. teach of a wheel cover.

U.S. Patent No. 7,316,420 issued to Loddo, U.S. Patent No. 6,786,512 issued to Morin et al., U.S. Patent No. 4,013,302 issued to Oswald, U.S. Patent No. 4,205,861 issued to Roberts et al., U.S. Patent No. 4,290,619 issued to Goodall, and U.S. Patent No. 4,334,694 issued to Iwanicki all teach of a various other spray guards.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN SWENSON whose telephone number is (571)272-6699. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Ellis can be reached on (571) 272-6914. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Brian Swenson
Examiner
Art Unit 3618

/B. S./
Examiner, Art Unit 3618

/Christopher P Ellis/
Supervisory Patent Examiner, Art Unit 3618